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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,813	05/30/2006	Gerald Sugerman	VOC 419US	5798

61650 7590 09/22/2008
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EXAMINER

FAISON GEE, VERONICA FAYE

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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09/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/526,813	Applicant(s) SUGERMAN, GERALD	
	Examiner VERONICA FAISON GEE	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Interpretation

The newly added claims recite a weight percent. The Examiner is interpreting the lower limit of this range to include zero, therefore inorganic salts of peracid do not have to be present in the composition.

Obvious Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 6-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/653,863 (2004/0211333). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said published claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 6-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-17 and 20 of copending Application No. 10/653,867. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said published claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 6-16, and 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-17 and 20 of copending Application No. 10/526,644. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said published claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 17, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Foster et al (US Patent 3,919,348).

Foster et al teach an epoxy-styrene solventless resin impregnation varnish, which is made by mixing (1) the product of the reaction of (a) 1 part of an epoxy resin mixture, (b) between about 0.01 to 0.06 part of maleic anhydride and (c) between about 0.0001 to 0.005 part of a catalyst with (2) a coreactive vinyl monomer and between about 0.00030 to 0.004 part of an aromatic acidic phenolic compound with (3) between about 0.3 to 1.2 part of a polycarboxylic anhydride which is soluble in the mixture of (1) and (2) at temperatures between about 0 to 35°C and an amount of free radical catalyst selected azo compounds and peroxide that is effective to provide a catalytic effect on the impregnating varnish to cure it at temperature over about 85°C (abstract and col. 1 line 54-col. 2 line 25). Cycloaliphatic and acyclic aliphatic type epoxides may also be used and are generally prepared by epoxidizing unsaturated aliphatic or unsaturated aromatic hydrocarbon compounds, such as olefins and cyclo-olefins, using hydrogen peroxide or peracid (col. 4 lines 45-52). The reference further teaches that peroxide is used as a free-radical type high temperature catalyst for the polymerization reaction that may be present in the amount of 0.001 to 0.01 part for each part of combined solid-liquid epoxy resin (col. 11 lines 39-63). In the example, the reference discloses water is used in the composition. The composition as taught by Foster et al appears to anticipate the claimed invention.

Claims 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernard et al (US Patent 2,406,795).

The reference teaches printing inks particularly designed for lithographic printing. The reference further teaches the pentaerythritol ester of tall oil as the principal vehicle of a lithographic Ink. It may be used as the sole non-volatile ingredient; although the ester is somewhat too viscous to be used in pure form, it can be reduced with a solvent having the necessary volatility characteristics. Most preferably, it is reduced to a desirable lithographing body by admixture with a relatively minor percentage of another drying oil. The ester can be made in conventional fashion by heating the tall oil and pentaerythritol together, preferably with a catalyst. This can be done, for example, by taking the theoretical equivalent quantities of the two materials (9% Of pentaerythritol and 91% of tall oil), and esterifying them at a temperature ranging from 200 to 250' C., using 1% of CaO as a catalyst. Carbon dioxide is bubbled through the oil to prevent oxidation and to carry off the water of esterification. The resultant ester has an acid number of about 10, and a viscosity which depends upon the source of the tall oil, and upon the resulting compositions. The thinnest ester can be used alone; the thicker esters are mixed with linseed oil to get the desired body. A mixture of about 4 parts of ester with a viscosity of 120 poises (obtained above from a tall oil containing 53% fatty acids, 39% resin acids and 7% unsaponifiable), and 1 part of a drying oil such as linseed or Perilla oil, gives a desirable body for a lithographic varnish. A similar varnish can be obtained by mixing drying oil acids with the tall oil before esterification. See examples. The reference appears to anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckwalter (US Patent 3,804,640).

Buckwalter teaches a solvent-free printing ink comprising an ink vehicle comprising an ester of a saturated or unsaturated aliphatic alcohol and a C₁₂ to C₂₀ unsaturated fatty acid, a film forming resin, and a metal salt of peroxydiphosphoric acid (abstract and col. 1 lines 58-66). The reference further teaches that the metal salt of peroxydiphosphoric acid is a catalyst that undergo cleavage to form radicals which cause the ester of the unsaturated fatty acid to polymerize and thus dry, wherein the metal is an alkali metal and alkaline earth metal (col. 2 lines 29-30 and col. 3 lines 5-40). The reference teaches that conventional additives such as wax slip and driers may be present in the ink composition (col. 2 lines 30-31). A pigment is usually present in the amount of 5 to 45 percent by weight in a printing ink (col. 4 lines 22-25). The reference remains silent to the type of printing ink (i.e. lithographic). However it is the position of the Examiner that because the same components are taught as disclosed by Applicant that the ink could be used as a lithographic ink to be used in a lithographic method absence tangible evidence to the contrary.

Response to Arguments

Applicant's arguments filed 6-26-08 have been fully considered but they are not persuasive.

Applicant states that the copending application 10/653,863 has been abandoned. However, according to the Patent Office status 10/653,863 has been allowed and therefore the rejection is maintained.

Applicant argues that does not disclose a composition containing inorganic peroxy acid salts the reference does not anticipate applicant's composition.

The Examiner respectfully disagrees. A prior art reference is good for all that it teaches not just the examples, this includes any intermediate compounds taught by the reference in making a final product. Therefore the rejection has been maintained.

Applicant argues that the greatest amount, applicant's catalyst is utilized in amount of less than ½ the minimum amounts disclosed by Buckwalter.

The Examiner agrees however, Buckwalter teaches that the catalyst is present in the amount of ***about*** 1 weight percent to about 10 weight percent. About permits some tolerance. At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%. *In re Ayers*, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). It is the position of the Examiner that Buckwalter still meets the limitation of the claimed invention and the rejection has been maintained.

Nonpreferred embodiments can be indicative of obviousness. *Merck & Co. v. Biocraft Laboratories Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1989); *In re Lamberti* 192 USPQ 278 (CCPA 1976); *In re Kohler* 177 USPQ 399 (CCPA 1973); *In re Mills* 176 USPQ 196

(CCPA 1972); *In re Bozek* 163 USPQ 545 (CCPA 1969); *In re Meinhardt* 157 USPQ 270 (CCPA 1968); *In re Boe* 148 USPQ 507 (CCPA 1976); *In re Nehrenberg* 126 USPQ 383. A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982). A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed. Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976); *In re Lamberti* 192 USPQ 278 (CCPA 1976); *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Preda* 159 USPQ 342 (CCPA 1968); *In re Van Mater* 144 USPQ 421 (CCPA 1965); *In re Jacoby* 135 USPQ 317 (CCPA 1962); *In re LeGrice* 133 USPQ 365 (CCPA 1962).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is (571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

/V. F. G./
Examiner, Art Unit 1793